

REMARKS

Information Disclosure Statement

Applicants' representative will telephone the Examiner to coordinate supplying the Examiner IDS references listed as "Other References".

Allowable Subject Matter

Applicants thank the Examiner for her remarks on allowable subject matter. Claim 21, referred to by the Examiner in part 7 (page 12) of the Office Action mailed June 15, 2004 as having allowable subject matter, has been canceled and its subject matter has been incorporated into independent claim 19. This has been done to expedite prosecution of the application, and Applicants reserve the right to prosecute claims outside this subject matter in this and other applications.

Claims 31 and 32 are also referred to as having allowable subject matter in part 8 (page 12) of the Office Action mailed June 15, 2004. These claims were given a 102(e) rejection in part 5 of the same Office Action. Applicants regard the 102(e) rejection as an oversight. Nevertheless, applicants respond herein to the 102(e) rejection of claims 31 and 32 on page 10 of this response.

THE AMENDMENTS

Applicants amend claims 19, 27, 30, 31, and 36, and cancel claim 21. Claim amendments are to expedite prosecution of the application. Claim amendments add no new subject matter, and are fully supported throughout the specification and by the drawings and claims as filed. Support and reasoning for the amendments are provided below.

Support for Claim Amendments and Reasons for Amendments

These amendments are made to clarify the claims and to expedite allowance of the present application.

Claim 19 has been amended to incorporate the phrase “wherein said multiple force chip comprises at least one acoustic element” from claim 21, which has been canceled.

Claim 27 has been changed only in claim dependency to correct an error in claim dependency in the original claim.

Claim 30 has been amended to replace the phrase “two or more chips” with “more than one chip”. This change in wording does not change the meaning of the claim.

Claim 31 has been amended to incorporate language from claim 19 and claim 30 and to make claim 31 an independent claim. Amended claim 31 therefore incorporates the language of original independent claim 19.

Claim 36 has been amended to correct an error in its dependency.

CLAIMS ARE DEFINITE UNDER 35USC §112, SECOND PARAGRAPH

The Examiner alleges that claims 30 through 36 are indefinite under 35 USC §112, Second Paragraph in the use of the wording “wherein one or more chips is two or more chips” in part c) of claim 30. Applicants disagree. The phrase “one or more” indicates a single entity or multiple entities, and “two or more” indicates multiple entities. Thus, “two or more” is a subset of “one or more”. Nevertheless, to expedite prosecution applicants have amended claim 30 such that the claim now reads “wherein one or more chips is more than one chip”. Claim 30 and claims 34 through 36 that directly or indirectly depend from claim 30 are definite under 35 USC §112, Second Paragraph. Applicants respectfully request that the rejection be removed.

CLAIMS WOULD NOT BE SUBJECT TO OBVIOUSNESS-TYPE DOUBLE PATENTING

The Examiner has alleged that claims 19, 20, 22, 24, 25, 28, 29, 30, and 34 through 36 would be subject to obviousness-type double patenting by U.S. Patent No. 6,716,642 (Wu) in view of U.S. Patent No. 6,432,630 (Blankenstein). Applicants disagree that U.S. Patent No. 6,716,642 discloses the invention substantially as claimed. Applicants further disagree that U.S. Patent No. 6,432,630 discloses a multiple force chip. However, to expedite allowance of claims, applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element” from claim 21, which has been canceled. U.S. Patent No. 6,716,642 does not claim a multiple force chip comprising at least one acoustic element, nor does U.S. Patent No. 6,432,630 disclose or suggest a multiple force chip comprising at least one acoustic element. Claims 20, 22, 24, 25, 28, 29 30, and 34 through 36 are directly or indirectly dependent on claim 19 and therefore incorporate the language of independent claim 19. Thus, claims 19, 20, 22, 24, 25, 28, 29 30, and 34 through 36 would not be subject to obviousness-type double patenting over the cited references, and Applicants respectfully request that the rejection be withdrawn.

The Examiner also alleges that claims 23 and 26 would be subject to obviousness-type double patenting over U.S. Patent No. 6,716,642 (Wu) in view of U.S. Patent No. 6,432,630 (Blankenstein), and further in view of U.S. Patent No. 6,056,861 (Fuhr). Applicants disagree that U.S. Patent No. 6,716,642 discloses the invention substantially as claimed. However, to expedite allowance of claims, applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element”. Neither U.S. Patent No. 6,432,630 nor U.S. Patent No. 6,432,630 nor U.S. Patent No. 6,056,861 discloses or suggests a multiple force chip comprising at least one acoustic element. Claims 23 and 26 are indirectly and directly dependent on amended claim 19. Thus, claims 23 and 26 would not be subject to obviousness-type double patenting over the cited references, and Applicants respectfully request that the rejection be removed.

The Examiner further alleges that claims 19, 20, 22, 24, 25, 27 through 30, and 33 through 36 would be subject to obviousness-type double patenting over U.S. Patent No. 6,355,491 (Zhou) due to obviousness in view of U.S. Patent No. 6,432,630

(Blankenstein). Applicants disagree that U.S. Patent No. 6,355,491 in view U.S. Patent No. 6,432,630 discloses the invention substantially as claimed. However, to expedite allowance of claims, applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element” from claim 21, which has been canceled. Neither U.S. Patent No. 6,355,491 nor U.S. Patent No. 6,432,630 discloses or suggests a multiple force chip comprising at least one acoustic element. Claims 20, 22, 24, 25, 27 through 30, and 33 through 36 are directly or indirectly dependent on claim 19. Thus, claims 20, 22, 24, 25, 27 through 30, and 34 through 36 would not be subject to obviousness-type double patenting over the cited references, and Applicants respectfully request that the rejection be removed.

The Examiner has also alleged that claims 23 and 26 would be subject to obviousness-type double patenting over U.S. Patent No. 6,355,491 (Zhou) in view of U.S. Patent No. 6,432,630 (Blankenstein), and further in view of U.S. Patent No. 6,056,861 (Fuhr). Applicants disagree that U.S. Patent No. 6,355,491 in view of U.S. Patent No. 6,432,630 discloses the invention substantially as claimed. However, to expedite allowance of claims, applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element”. Claims 23 and 26 are indirectly and directly dependent on amended claim 19. Neither U.S. Patent No. 6,355,491 nor U.S. Patent No. 6,432,630 nor U.S. Patent No. 6,056,861 disclose or suggest a multiple force chip that comprises at least one acoustic element. Thus, claims 23 and 26 would not be subject to obviousness-type double patenting over the cited references, and Applicants therefore respectfully request that the rejection be removed.

CLAIMS ARE NOVEL UNDER 35 USC §102(E)

The Examiner alleges that claims 19, 20, 22, 24, 25, and 28 through 36 are anticipated by U.S. Patent No. 6,432,630 (Blankenstein). Applicants disagree that Blankenstein discloses a biochip system comprising a multiple force chip, wherein the system can perform two or more sequential tasks, in which at least one of the sequential tasks is a processing task.

However, to expedite allowance of claims, Applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element” from claim 21, which has been canceled. Blankenstein does not disclose a multiple force chip that comprises at least one acoustic element. Claims 20, 22, 24, 25, 28 through 30, and 34 through 36 directly or indirectly dependent from claim 19, and therefore incorporate the language of amended claim 19.

The Examiner has not cited any references that pertain to the subject matter that is particular to claims 31 through 33, namely, a multiple chip system in which “at least two of the two or more chips can be, for at least a part of the time during the operation of the integrated biochip system, in fluid communication with one another”. The Examiner has indicated (point 8 of the Office Action mailed June 15, 2004) that claim 31 would be allowable if it were rewritten to overcome the rejections under 35 USC §112, Second Paragraph set forth in that Office action and to include all of the limitations of the base claim and any intervening claims. Therefore Applicants regard the inclusion of claim 31 and claims 32 and 33 that are directly and indirectly dependent on claim 31 in this rejection to be an oversight.

Applicants have amended claim 31 so that it is now an independent claim that includes the limitations of base claim 19 (prior to amendment) and intervening claim 30. Amended claim 31 and claims 32 and 33 that depend from claim 31 are therefore novel under 35 USC §102. Applicants therefore respectfully request that the rejection be removed.

CLAIMS ARE NONOBVIOUS UNDER 35USC §103(A)

The Examiner alleges that claims 23 and 26 are unpatentable due to obviousness over U.S. Patent No. 6,432,630 (Blankenstein) in view of U.S. Patent No. 6,056,861 (Fuhr). Applicants disagree that U.S. Patent No. 6,432,630 discloses the invention substantially as claimed. However, to expedite allowance of claims, applicants have amended independent claim 19 to include the phrase “wherein said multiple force chip comprises at least one acoustic element”. Claims 23 and 26 are indirectly and directly dependent on amended claim 19. Neither U.S. Patent No. 6,432,630 nor U.S. Patent No. 6,056,861 disclose or suggest a multiple force chip that comprises at least one acoustic element. Thus, claims 23 and 26 are nonobvious over U.S. Patent No. 6,716,642 in view of U.S. Patent No. 6,056,861, and Applicants therefore respectfully request that the rejection be removed.

Applicants submit that the claims are ready for examination and in condition for allowance.

Respectfully submitted,

Date: July 27, 2004

A handwritten signature in black ink, appearing to read "David R. Preston", written over a horizontal line.

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In the event this paper is deemed not timely filed the applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 501,321 along with any other additional fees which may be required with respect to this paper; any overpayment should be credited to the account. If any fees charged to this account will exceed \$500, applicants respectfully requests that its counsel be notified of such amounts before the Deposit Account is charged.